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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Park, Jaehwa, et al. Petitions Attorney: Brown, Alesia M.
Serial No.: 10/692,618 Art Unit: 2622
Filed: October 24, 2003 Docket No.: CS21560RL
Title: METHOD AND APPARATUS FOR BESIER CURVE APPROXIMATION
DATA COMPRESSION

Motorola, Inc.
Law Department
600 North U.S. Highway 45, AS437
Libertyville, IL 60048

REQUEST FOR RECONSIDERATION OF PETITION UNDER 37 CFR 1.47(a)

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:


This reply is in response to the decision of April 28, 2005, dismissing Applicants' petition under 37 CFR 1.47(a), filed March 9, 2004. This reply is filed within two months from the mailing date of the above decision.

The above decision states that the Applicants' petition fails to establish proof that the non-signing inventor could not be reached or refused to sign the oath or declaration after having been presented with an acceptable oath or declaration in compliance with 35 U.S.C. §§115 and 116. Accordingly, Applicants' representative hereby submits an accompanying STATEMENT OF FACTS TO ESTABLISH NON-SIGNING INVENTOR COULD NOT BE LOCATED in order to establish this proof. Reconsideration and withdrawal of the dismissal of the above petition are respectfully requested.

Should the Petitions Attorney have any questions or concerns that may expedite a grant of the above petition, the Petitions Attorney is encouraged to telephone the undersigned.

Respectfully submitted,

Please forward all correspondence to:
Motorola, Inc.
Law Department (HDW)
600 North US Highway 45, AS437
Libertyville, IL 60048

 06/20/05
Hisashi D. Watanabe Date
Attorney for Applicant(s)
Registration No. 37,465
Telephone: (847) 523-2322
Facsimile: (847) 523-2350



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Motorola, Inc.
Law Department
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STATEMENT OF FACTS TO ESTABLISH
NON-SIGNING INVENTOR COULD NOT BE LOCATED

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The specification for the above-identified U.S. patent application was filed on October 24, 2005, as Application Serial No. 10/692,618.

This statement is made as to the exact facts that are relied upon to establish the diligent effort made to secure the execution of the declaration by the non-signing inventor for the above application before deposit thereof in the United States Patent and Trademark Office.

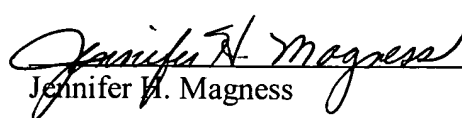
Because signing on behalf of the non-signing inventor is by a person or entity showing a sufficient proprietary interest, this statement also recites facts as to why this action was necessary to preserve the rights of the parties or to prevent irreparable damage.

This statement is being made by the available person having first-hand knowledge of the facts recited therein, namely Jennifer H. Magness.

1. The following papers accompany this Statement:
 - a) a Federal Express package and airbill sent to Charles Wang on September 11, 2003, including a cover letter, a complete copy of the patent application (specification, including claims, drawings and unexecuted declaration), and an unexecuted assignment; and
 - b) an email message sent to Manjirnath ("Manu") Chatterjee on September 11, 2003, including the same attachments sent to Charles Wang.
2. Although I made diligent and bonafide effort to locate the non-signing inventor, namely Jaehwa Park, and provide the non-signing inventor with a complete copy of the patent application (specification, including claims, drawings and declaration), I could not reach or located him for presentation of the application papers as of the date when the above petition was filed.
3. The accompanying Federal Express package and airbill sent to Charles Wang is evidence that a complete copy of the patent application was sent to him on September 11, 2003.
4. The accompanying email message sent to Manu Chatterjee is evidence that a complete copy of the patent application was sent to him on September 11, 2003.
5. It is our department procedure to send a complete copy of the every patent application to each inventor if the inventor is asked to execute a declaration. I have always complied with this department procedure to the best of my ability, and I do not have any knowledge of deviating from this procedure.

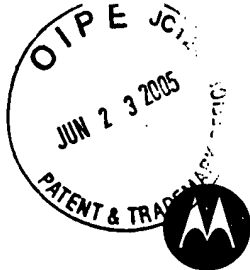
6. On August 27, 2003, after Jaehwa Park left the employ of Motorola Inc., I attempted to contact him via email, which was never answered, and by telephone to his listed home telephone number, which was found to be disconnected.
7. On September 30, 2003, I sent a letter and document via Federal Express to Jaehwa Park asking his assistance with the filing of the above patent application and with the execution of the declaration and assignment documents, in accordance with his employment agreement with Motorola Inc. No response had been received.
8. The Federal Express airbill, number 842738667020, and tracking information submitted with the above petition on March 9, 2004, is evidence that I sent a standard Federal Express envelope to the last known address of Jaehwa Park on September 30, 2003.
9. Based on our department procedure and my historical compliance with this procedure, I believe that a complete copy of the above patent application was enclosed in the standard Federal Express envelope sent to Jaehwa Park on September 30, 2003. I do not have any knowledge of deviating, or any reason to believe that I deviated, from this procedure.

Respectfully submitted,


Jennifer H. Magness 06/20/05
Date

Motorola, Inc.
Law Department
600 North U.S. Highway 45, AS4375
Libertyville, IL 60048

Telephone: (847) 523-2345
Facsimile: (847) 523-2350



MOTOROLA

*Intellectual Property Department
Patents, Trademarks and Licensing*

DATE: September 11, 2003
TO: Charles Wang
FROM: Jennifer Magness
Administrative Assistant
Re: Docket No. CS21560RL

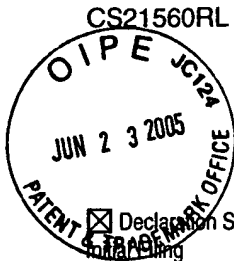
We are preparing to file the above referenced patent application with the United States Patent Office.

Enclosed please find the Assignment and Declaration Forms for your signature. Please sign the forms where indicated and return all originals (**a total of nine pages**) to me in the enclosed Fed Ex envelope no later than **September 16th**. **Note: the Assignment form needs to be signed in the presence of a Notary or two witnesses if a Notary is unavailable.** A copy of the specification and drawings as filed are enclosed for your files.

If you have any questions or if I can be of assistance, please feel free to call me at (847) 523-2345.

Regards

Personal Communications Sector
600 North U.S. Highway 45, AN 475
Libertyville, IL 60048
Phone: (847) 523-2345 Facsimile: (847) 523-2350



**DECLARATION FOR UTILITY OR DESIGN PATENT APPLICATION (37 CFR 1.63)
COMBINED WITH POWER OF ATTORNEY**

☒ Declaration Submitted with Initial Filing

☐ Declaration Submitted after Initial Filing (surcharge (37 CFR 1.16(e)) required)

Attorney Docket Number

CS21560RL

First Named Inventor

Park, Jaehwa et al.

Application Number

Filing Date

Herewith

☒ Regular (Utility) Application

☐ Design application

Group Art Unit

Examiner Name

As a below named inventor, I hereby declare that:

My residence, post office address, and citizenship are as stated below next to my name.

I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled:

METHOD AND APPARATUS FOR BEZIER CURVE APPROXIMATION DATA COMPRESSION

the specification of which:

☒ is attached hereto

☐ was filed on:

as U.S. Serial No.:

and was amended on:

(if applicable)

I hereby state that I have reviewed and understand the contents of the above-identified specification, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose information which is material to the patentability of this application in accordance with Title 37, Code of Federal Regulations, Section 1.56(a).

I hereby claim foreign priority benefits under Title 35, United States Code, Section 119(a)-(d) or (f), or 365(b) of any foreign application(s) for patent or inventor's certificate(s), or 365(a) of any PCT international application which designated at least one country other than the United States of America, listed below and have also identified below, by checking the box, any foreign application for patent, inventor's certificate(s), or any PCT international application having a filing date before that of the application on which priority is claimed:

Prior Foreign Application Number(s)	Country	Foreign Filing Date (MM/DD/YYYY)	Priority Not Claimed	Certified Copy Attached?
				<input type="checkbox"/> Yes <input type="checkbox"/> No
				<input type="checkbox"/> Yes <input type="checkbox"/> No

☐ Additional foreign application numbers are listed on a supplemental priority data sheet PTO/SB/02B attached hereto:

I hereby claim the benefit under Title 35, United States Code § 119(e) of any United States provisional application(s) listed below:

Provisional Application Serial No.:	
Provisional Application Filing Date:	

I hereby claim the priority benefit under Title 35, United States Code, Section 120 of any United States application(s) listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States application in the manner provided by the first paragraph of Title 35, United States Code, Section 112, I acknowledge the duty to disclose material information as defined in Title 37, Code of Federal Regulations, Section 1.56(a) which is material to the patentability of this application and which occurred between the filing date of the prior application and the national or PCT international filing date of this application:

Prior U.S. Application(s):

☒
☐

no such application(s) filed
such application(s) identified as follows:

Application No.	Filing Date (day, month, year)	Status (Patented, Pending, Abandoned)

I hereby declare that: as to any claimed subject matter of this application which is common to my earlier United States or foreign application(s), if any, which I have identified above and claimed the benefit of priority thereof, I do not believe that the same was ever known or used in the United States before my invention thereof or patented or described in any printed publication in any country before my invention thereof or more than one year prior to the first of said earlier application(s), or in public use or on sale in the United States more than one year prior to the first of said earlier application(s), and that the said common subject matter has not been patented or made the subject of an inventor's certificate before the date of the first of said earlier U.S. application(s) in any country foreign to the United States on an application, filed by me or my legal representatives or assigns more than twelve months (six months if the present application is a Design patent application) prior to the first of said earlier U.S. application(s), if any; and that, as to any claimed subject matter of this application which is not common to said earlier application(s), if any, I do not know and do not believe that the same was ever known or used in the United States before my invention thereof or patented or described in any printed publication in any country before my invention thereof or more than one year prior to the date of this application, or in public use or on sale in the United States more than one year prior to the date of this application, and that said subject matter has not been patented or made the subject of an inventor's certificate in any country foreign to the United States on an application filed by me or my legal representatives or assigns more than twelve months (six months if the present application is a Design patent application) prior to the date of this application.

I hereby appoint the attorney(s) or agent(s) associated with: 20280 to prosecute this application and transact all business in the patent and trademark office connected therewith.

Address all telephone calls to:

Shigeharu Furukawa
Telephone: 847-523-1987
Facsimile: 847-523-2350

Address all correspondence to: Customer Number 20280

Full Name of Sole or First Inventor: Jaehwa Park

<u>6467 Standridge Ct.</u>			
Mailing Address			
<u>San Jose</u>	<u>CA</u>	<u>95123</u>	<u>United States</u>
City	State	Postal Code	Country

Full Name of Second-Joint Inventor: <u>Manjirath A. Chatterjee</u>			
<u>Inventor's Signature</u>			<u>Date</u>
<u>Sunnyvale</u>	<u>CA</u>	<u>94086</u>	<u>United States of America</u>
Residence: <u>City</u>	<u>State</u>	<u>Postal Code</u>	<u>Country of Citizenship</u>
<u>247 Arriba Drive #9</u>			
<u>Mailing Address</u>			
<u>Sunnyvale</u>	<u>CA</u>	<u>94086</u>	<u>United States</u>
<u>City</u>	<u>State</u>	<u>Postal Code</u>	<u>Country</u>

Full Name of Third-Joint Inventor: Charles Wang

Inventor's Signature			Date
<u>Aliso Viejo</u>	<u>CA</u>	<u>92656</u>	<u>United States of America</u>
Residence: <u> </u>	<u> </u>	<u> </u>	<u> </u>
City	State	Postal Code	Country of Citizenship

9 Cameo Drive

Mailing Address

<u>Aliso Viejo</u>	<u>CA</u>	<u>92656</u>	<u>United States</u>
City	State	Postal Code	Country

PATENT

ASSIGNMENT AND AGREEMENT

For good and valuable consideration, the receipt of which is hereby acknowledged, we, **JAEHWA PARK, SAN JOSE, CA, MANJIRNATH A. CHATTERJEE, SUNNYVALE, CA; and CHARLES WANG, ALISO VIEJO, CA,** have sold, assigned and transferred, and do hereby sell, assign and transfer, unto **MOTOROLA, INC.**, a corporation of the State of Delaware, having its principal office in Schaumburg, State of Illinois, United States of America, and its successors, assigns, and legal representatives, the entire right, title and interest for the United States of America in and to certain inventions relating to improvements in **METHOD AND APPARATUS FOR BEZIER CURVE APPROXIMATION DATA COMPRESSION** (Docket No. **CS21560RL**), described, illustrated and claimed in an application for Letters Patent of the United States of America executed by us on the dates indicated by our signatures below, together with the entire right, title and interest in and to the application, and in and to Letters Patent which may be issued upon the application, and upon any division, extension, continuation or reissue thereof.

We hereby also sell, assign and transfer unto **MOTOROLA, INC.**, the entire right, title and interest in and to the invention and in and to applications for Letters Patent therefor in all countries foreign to the United States of America, including all rights under any and all international conventions and treaties in respect of the invention and the applications for Letters Patent in foreign countries, and we further authorize **MOTOROLA, INC.** to apply for Letters Patent in foreign countries directly in its own name, and to claim priority of the filing date of the application for Letters Patent of the United States of America under the provisions of any and all international conventions and treaties.

We hereby authorize and request the Commissioner of Patents of the United States of America to issue Letters Patent upon the aforesaid application, division, extension, continuation or reissue, to **MOTOROLA, INC.**, for the sole use and benefit of **MOTOROLA, INC.**, its successors, assigns and legal representatives, to the full end of the term for which Letters Patent may be granted, the same as they would have been held and enjoyed by me had this assignment not been made, and we hereby authorize and request the equivalent authorities in foreign countries to issue the patents of their respective countries to **MOTOROLA, INC.**

We agree that, when requested, we will, without charge to **MOTOROLA, INC.**, but at its expense, sign all papers, take all rightful oaths, and do all acts which may be necessary, desirable or convenient for securing and maintaining patents for the inventions in any and all countries and for vesting title thereto in **MOTOROLA, INC.**, its successors, assigns and legal representatives or nominees.

We covenant with MOTOROLA, INC., its successors, assigns and legal representatives, that the interest and property hereby conveyed is free from all prior assignment, grant, mortgage, license or other encumbrance.

JAEHWA PARK

DATE: _____

Witness Signature

Printed Name of Witness

Witness Signature

Printed Name of Witness

MANJIRNATH A. CHATTERJEE

DATE: _____

STATE OF CA)
)ss
COUNTY OF)

The undersigned Notary Public in and for the County and State aforesaid, do hereby certify that Manjirnath A. Chatterjee whose name is subscribed to the foregoing instrument, appeared before me this day in person and acknowledged that they signed, sealed and delivered the instrument as their free and voluntary act and deed for the uses and purposes therein set forth.

Given under my hand and notarial seal this ____ day of _____, 2003.

My commission expires:

Notary Public Signature

Printed Name of Notary Public

CHARLES WANG

DATE: _____

STATE OF CA)
)ss
COUNTY OF)

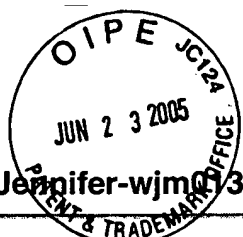
The undersigned Notary Public in and for the County and State aforesaid, do hereby certify that Charles Wang whose name is subscribed to the foregoing instrument, appeared before me this day in person and acknowledged that they signed, sealed and delivered the instrument as their free and voluntary act and deed for the uses and purposes therein set forth.

Given under my hand and notarial seal this ____ day of _____, 2003.

My commission expires:

Notary Public Signature

Printed Name of Notary Public



Magness Jennifer-wjmc13

To: Chatterjee Manu-FMC045

Subject: Patent Application Docket No. CS21560RL

Manu,

We are preparing to file the above referenced patent application with the United States Patent Office.

Enclosed please find the Assignment and Declaration Forms for your signature. Please sign the forms wh indicated and return all originals (**a total of nine pages**) to me no later than **September 16th**. Note: the Assignment form needs to be signed in the presence of a Notary or two witnesses if a Notary is unavail
A copy of the specification and drawings are enclosed for your files.

If you have any questions or if I can be of assistance, please feel free to call me at (847) 523-2345.

Regards

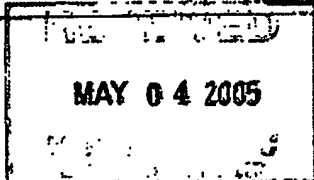
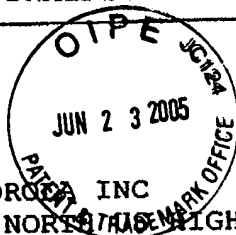
Jennifer Magness
Administrative Assistant
Intellectual Property Section
Law Department
600 North U.S. Highway 45, AN475
Libertyville, IL 60048
847-523-2345

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9/11/2003



UNITED STATES PATENT AND TRADEMARK OFFICE



COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1480
ALEXANDRIA, VA 22318-1480
www.uspto.gov

NOT 6

MOTOROLA INC
600 NORTH HASENDRUP HIGHWAY 45
ROOM AS437
LIBERTYVILLE, IL 60048-5343

COPY MAILED

APR 28 2005

OFFICE OF PETITIONS

DOCKETED

MAY 10 2005

MOTL PATENT DEPT

In re Application of
Park, et al.
Application No. 10/692,618
Filed: October 24, 2003
Atty. Dkt. No.: ~~10/692,618~~ PARK
For: METHOD AND APPARATUS FOR
BEZIER CURVE APPROXIMATION DATA
COMPRESSION

:
: DECISION REFUSING STATUS
: UNDER 37 CFR 1.47(a)
:
:
:
:
:

This decision is in response to the petition under 37 CFR 1.47(a), filed March 9, 2004.

The petition is DISMISSED.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the legal representative of the deceased inventor. Failure to respond will result in abandonment of the application. Any extensions of time will be governed by 37 CFR 1.136(a).

The above-identified application was filed October 24, 2004 without an executed oath or declaration. Accordingly, a Notice to File Missing Parts of Nonprovisional Application was mailed February 4, 2004 requiring an executed oath or declaration and a surcharge.

A grantable petition under 37 CFR 1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor.

Application No. 10/692,618

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The instant petition fails to satisfy item (1). Petitioners indicate that attempts to contact the non-signing inventor via email and telephone on August 27, 2003 were unsuccessful. Petitioners further indicate that a letter and document were sent to the non-signing inventor at the non-signing inventor's last known address and that no response was received.

It is unclear if petitioners are asserting that the non-signing inventor cannot be reached or located for presentation of the application papers or if petitioners are asserting that the non-signing inventor has refused to execute the declaration after having been presented with the application papers.

Where inability to reach or locate a non-signing inventor is alleged, petitioners are required to establish that diligent effort was made to locate the non-signing inventor and provide the non-signing inventor with a complete copy of the patent application (specification, including claims, drawings, and oath or declaration). Petitioners have not established that diligent effort has been made to locate the non-signing inventor for presentation of the application papers.

Any renewed petition must be supported by evidence that sufficiently establishes that despite diligent effort, the non-signing inventor cannot be located. A statement of facts should be submitted that fully describes the exact facts that are relied on to establish that a diligent effort was made to locate the non-signing inventor. The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay, will not normally be accepted. At the very least, a search of the internet, human resource records, telephone directories, and international registries should be undertaken in regions where it is suspected the non-signing inventor may reside. Petitioner should reference and supply evidence of any such searches in a renewed petition. See, MPEP 409.03(d).

Before a refusal to sign an oath or declaration can be alleged, it must be demonstrated that a *bona fide* effort has been made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor. Petitioners have failed to establish that the non-signing inventor received a copy of the application papers (specification, claims, drawings, and oath or declaration) and thereafter refused to execute the oath or declaration. Any renewed petition should be accompanied by evidence to establish that the non-signing inventor was sent a complete copy of the

Application No. 10/692,618

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application papers (specification, claims, drawings, and oath or declaration) and thereafter refused to execute the declaration. Petitioners may wish to provide the Office copies of letters sent to the inventors indicating the enclosure of the application papers (specification, claims, drawings, and oath or declaration). If after the inventor receives the application papers and requests to execute the oath or declaration are refused, these facts should be set forth in a statement of facts signed by the person to whom the refusals were made and detailing with specificity the exact manner of the refusals. If a written refusal has been made, a copy of the written refusal should be included on renewed petition.

Further correspondence with respect to this matter should be addressed as follows:

By mail:

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By facsimile:

(703) 872-9306

By hand:

U.S. Patent and Trademark Office
Customer Window
Mail Stop Petition
Randolph Building
Dulany Street
Alexandria, VA 22314

Telephone inquiries regarding this decision should be directed to the undersigned at (571) 272-3205.



Alesia M. Brown
Petitions Attorney
Office of Petitions